

the Coran patent which equates certain features with those of pending independent claims 1 and 7 is not supportable.

**The Combination of References Does Not Meet
the Controlling Legal Standard Under 35 U.S.C. §103(b)**

As a preliminary matter, we believe that it would be helpful to review the appropriate standard under 35 U.S.C. §103 for analyzing the features of a claim with respect to the prior art. It is well settled that the test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the “gist” or “core” of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

The references must be taken in their entirety, including those portions which argue against obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986). It is impermissible within the framework of the 35 U.S.C. § 103 to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. Id. at 419.

For prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability,

and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 496 (C.C.P.A. 1970), M.P.E.P. 2143.03. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem being solved. Pro-Mold & Tool Co. v. Great Lakes

Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ 2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teaching of the pertinent references. In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See Dembiczak, 175 F.3d at 1000, 50 USPQ 2d at 1617.

The Disclosures of the Prior Art References Do Not Comprehend the Limitations of the Claims

Contrary to the assertions in the Office Action, there are several clear differences between the pending claims and the Coran disclosure, which include at least the following significant limitations:

- 1. The turret 6 is supported by means which permit it to effect a second vertical translation movement between a first higher point under the extraction arm and a second lower position.*

This limitation was apparently overlooked in the analysis set forth in the Office Action, for it is not mentioned as a limitation found in either of the cited references.

In Coran the turret 3 is capable of only a rotational movement and is not capable of any vertical movement. This is affirmed in paragraphs 75 and 77 of Coran. In fact, the turret 3 of Coran never rises to come closer to the extraction plate 2 to collect the preforms as is claimed in the operation of the apparatus and the process/method claims of the present invention. This limitation is found in claim 1 at lines 15 – 19 and in claim 7, subparagraph (i).

Moreover, Coran, as recognized by the Examiner also does not disclose:

2. *An extraction table for the objects 5 which possesses grasping elements able to extract the objects from the cups 7 of the turret 6 and which is situated beneath said lower position of the turret 6.*

The Office Action then describes various elements disclosed in Brun, but does not accurately characterize the disclosure or functioning of Brun. Applicants respectfully submit that when fairly read it will be agreed that Brun must be limited to the following:

An extraction or take-out apparatus for an injection mold comprising two half-molds 24, 26 defining in closed position, a plurality of injection cavities of the preforms, wherein the half-molds have a translation motion of reciprocal distancing and nearing, defining a closed position and an open position, an extraction arm 40 from the mold of the preforms, provided with reversible gripping elements for said objects, provided with translational movement between a first insertion position in the space between the half-molds when the latter are in their open position, and a second position outside the half-molds.

Therefore, Brun teaches only some of the technical elements of Coran because the extraction arm 40 of Brun has the same functions and corresponds, in the injection mold, to the extraction arm 2 of Coran, not to the preform extraction apparatus.

In Coran, the apparatus for extracting the preforms from the injection mold is indicated by numeral 2, and by numeral 3 in the present application. See Figures 22-24 of Coran. Even if it were possible to combine the teachings of Coran with those of Brun, (and applicants do not

concede that support could be found for the combination), the extraction table (21) of the present claims would still be missing. The limitation of the extraction table is found in applicants' claim 1, lines 17 – 19, and in claim 7, subparagraph (I).

Brun does not have a rotating turret for cooling the preforms and the turret 3 as disclosed in Coran is already equipped with a preform extraction device (Figures 22 to 24 of Coran) that is incorporated into the turret itself. There can be no motivation or common sense reason for one of ordinary skill in the art to even consider replacing the preform extraction device in Coran's turret 3 with an external preform extraction table as required by applicants' claims.

Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness by providing any suggestion, motivation or other common sense reasoning that might occur to one of ordinary skill in the art as to why the teaching by Brun should be applied on a separate extraction table placed under the cooling turret 3 of Coran. No extraction table exists in either Coran or in Brun because, as discussed above, Brun teaches only a preform extraction apparatus with an arm 40 to extract preforms from within the injection mold just after injection, not after cooling.

For the above reasons, applicants respectfully submit that the obviousness rejection is untenable and that any *prima facie* case of obviousness has been rebutted as being based solely on hindsight using applicant's disclosure and claims as a guide. Furthermore, the obviousness rejection is improper because it fails to show important limitations of the apparatus of claim 1, and process claim 7. There is no evidence presented in the Office Action as to how to modify the references, and the Office Action provides no suggestion of how the disclosures of Coran and Brun can logically be combined to provide an operable device meeting the limitations of applicants' claimed invention as a whole.

Petition for Extension of Time

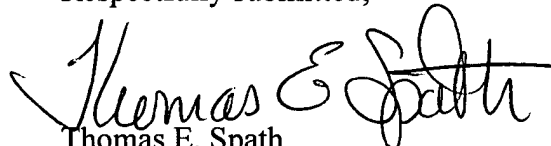
A petition for a three-month extension of time is being submitted with this Amendment.

Conclusion

The Applicants submit that the analysis and discussions presented above respond to all of the points raised in the Office Action and that all the claims have been shown to be in condition for allowance. Accordingly, favorable reconsideration of this application and prompt issuance of a Notice of Allowance are respectfully requested.

In the event that the Examiner believes that there are any unresolved issues in any of the claims now pending in the application, we respectfully request that the Examiner telephone Thomas E. Spath at (212) 885-9250 or Steven M. Hertzberg at (212) 885-9223 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,


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